

REMARKS

Claims 15 through 17 are pending in this Application. Claims 15 through 17 have been amended to clarify that the claimed plating bath precursor is formulated for redox system electroless plating wherein the first metal ions are substantially not deposited during plating and the second metal ions are deposited during plating. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, page 21 of the written description of the specification, line 17 through page 24 thereof, line 6. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 15 through 17 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Odanaka et al. in view of Kitada et al.

In the statement of the rejection the Examiner asserted that Odanaka et al. disclose a plating bath corresponding to that claimed, but **admitted** that Odanaka et al. do **not** disclose the appropriate composition comprising complex forming agent and stabilizer. The Examiner, however, concluded that one having ordinary skill in the art would have been motivated to modify the plating bath of Odanaka et al. by incorporating a complex forming agent and stabilizer in view of Kitada et al., a reference the Examiner asserts evinces the conventionality of incorporating such components. This rejection is traversed.

In the Amendment submitted with the Request for Continued Examination (RCE) pursuant to 37 C.F.R. § 1.114 on June 16, 2004, it was strenuously argued that the claimed plating bath and the plating bath disclosed by Odanaka et al. are fundamentally different. Specifically, it was argued that one having ordinary skill in the art would have interpreted the claimed invention as an **electroless** plating bath. On the other hand, and the Examiner does **not gainsay**, the plating bath

disclosed by Odanaka et al. is an **electroplating** bath. It is **not** disputed on this record that there are art-recognized differences between an electroless plating bath as claimed, and an electroplating bath as disclosed by Odanaka et al. See, for example, page 1 of the written description of the specification, lines 9 *et seq.*

In responding to these arguments the Examiner, commencing in the fourth enumerated section on page 5 of the July 15, 2004 Office Action, asserts that the claims are not limited to an electroless plating bath precursor. But the Examiner did **not** address the argument advanced which is that one having ordinary skill in the art would have **interpreted** the claimed plating bath precursor as an electroless plating bath precursor in light of and consistent with the specification. This argument is repeated now and must be accepted because the Examiner did not dispute that argument. At any rate, in order to expedite prosecution, independent claim 17 has been amended, as have dependent claims 15 and 16, to clarify that the claimed plating bath is formulated for redox system **electroless** plating – **not electroplating** as is the bath disclosed by Odanaka et al.

Moreover, the claimed plating bath precursor is formulated with first metal ions which are not substantially deposited in plating and with second metal ions which are deposited in plating. No such plating bath is disclosed or suggested by Odanaka et al. This limitation further crystallizes the difference between the claimed electroless plating bath and that disclosed by Odanaka et al. wherein every metal corresponding to the first metal deposits. For clarification, Applicants would invite the Examiner's attention to the object of the present invention set forth at page 5 of the written description of the specification, lines 15 *et seq.*

Applicants submit that the above argued fundamental differences between the claimed **electroless** plating bath precursor and the **electroplating** bath of Odanaka et al. are not cured by the secondary reference to Kitada et al. Accordingly, even **if** the references are combined as suggested

by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applications, therefore, submit that the imposed rejection of claims 15 through 17 under 35 U.S.C. § 103 for obviousness predicated upon Odanaka et al. in view of Kitada et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 15 through 17 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Traini et al. in view of Kitada et al.

In the statement of the rejection the Examiner then again concluded that one having ordinary skill in the art would have been motivated to modify the plating bath disclosed by Traini et al., which is an **electroplating** bath, by incorporating a complex forming agent and stabilizer in view of Kitada et al. This rejection is traversed.

As previously argued, it is **without dispute** on this record that Traini et al. disclose an **electroplating** bath. The claimed invention is directed to an **electroless** plating bath. There is no dispute that there are art-recognized differences between an electroless plating bath, as claimed, and an **electroplating** bath as disclosed by Traini et al. Moreover, in accordance with the claimed electroless plating bath, the first metal ions are not substantially deposited, but the second metal ions are. In accordance with the **electroplating** bath disclosed by Traini et al., all of the first metal ions are deposited.

The above argued differences between the claimed **electroless** plating bath precursor and the **electroplating** bath of Traini et al. are not cured by Kitada et al. Accordingly, even if the electroplating bath disclosed by Traini et al. is modified as suggested by the Examiner, and

Serial No.: 10/036,506

Applicants again do not agree that the requisite fact-based motivation has been established, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.*


Applicants, therefore, submit that the imposed rejection of claims 15 through 17 under 35 U.S.C. § 103 for obviousness predicated upon Traini et al. in view of Kitada et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP


Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
202.756.8000 AJS:bjs:ntb
Facsimile: 202.756.8087
Date: September 9, 2004